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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,956	12/17/2001	Frank William Schadewald JR.	STL 10019.00 (30874.113US)	1979
23552	7590	01/12/2004	EXAMINER CHEN, TIANJIE	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			ART UNIT 2652	PAPER NUMBER 14
DATE MAILED: 01/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,956

Applicant(s)

SCHADEWALD ET AL.

Examiner

Tianjie Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 21 is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☒ Interview Summary (PTO-413) Paper No(s). 13.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Non-Final Rejection (RCE)

Priority

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2003 has been entered. Claims 1-10 and 18-21 are pending.

Telephone Interview

2. In telephone interview conducted on 01/05/2004, Applicant agrees on the following amendment:

- In claim 1, lines 2; --magnetic read/write-- is inserted before "head."
- In claim 18, line 1; --for protecting a magnetic read/write head assembly circuit from electrostatic discharge-- is inserted before "comprising."

Examiner also requires here to further amend claim 21 as follows:

- In claim 21, line 1; --for protecting a magnetic read/write head assembly circuit from electrostatic discharge-- is inserted after "device."

To confirm the agreed and required amendments, Applicant is required to include the above amendments in the next response.

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Drawings

3. The drawings are objected to because:

- In FIG.11A, "FIG.11A" should be changed to --FIG.11--.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Johansen (US 5,963,415).

With regard to claims 18 and 19, Johansen shows a protection device as described above, which includes: means for electrically communicating with a circuit to be protected; and means for reversibly shorting a portion of the circuit to be protected by lifting means 56 for electrically communicating relative to the circuit 16 during operation of the device so as to separate the means for electrically communicating and the circuit, and returning the means for electrically communicating from the lifted position relative to the circuit to a position in which the means for electrically communicating and the circuit are electrically connected; a pair of electrical contacts that are moveable from a first position in which the electrical contacts are in electrical communication with the circuit to be protected to a second

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position in which the electrical contacts are not in electrical communication with the circuit to be protected.

Allowable Subject Matter

5. Claims 1-10 and 21 are allowed.

Claim 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

- With regard to claim 1, Johansen (US 5,963,415) shows an electrostatic discharge protection device for protecting magnetic read/write head assembly having a shunt, the shunt has a first position and second position, **but fails to show** that the second position is within the housing.

Applicant's invention keeps the communicating means in the device all the time.

- With regard to claims 20 and 21, as the closest reference, Johansen (US 5,963,415) shows an electrostatic discharge protection device for protecting magnetic read/write head assembly having a deshunting pin, but fail to show a deshunting rail.

Applicant's rail can be moved manually or moved by a mechanical testing apparatus between the shunted and unshunted positions (Specification, p. 7, lines 13-15).

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Response to Arguments

6. Applicant's arguments filed 11/10/2003 have been fully considered but they are not persuasive.

- Johansen does show that the means for electrically communicating relative to the circuit is lifted during operation of the device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is (703) 305-7499. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is (703)746-6037.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Chen Franke 01/06/04

Tianjie Chen
Primary Examiner
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